

REMARKS/ARGUMENTS

Status of Claims

Claims 1-25 were pending in this application before the present response. In the Office Action dated December 6, 2007, claims 18-20 stand rejected under 35 U.S.C. § 102(e), and claims 1-17 and 21-25 stand rejected under 35 U.S.C. § 103(a).

No claims have been amended in this response. No new matter is added. Any remarks made herein with respect to a given claim is intended only in the context of that specific claim, and should not be applied to other claims, amendments, or aspects of Applicants' invention.

Claims 1-25 are now pending in this application. Applicants respectfully request reconsideration and allowance of all pending claims, in view of the following remarks.

Statement Concerning Common Ownership

U.S. Patent Application No. 10/772,816 and U.S. Patent No. 6,990,203 were, at the time the invention of U.S. Patent Application No. 10/772,816 was made, commonly owned by General Instrument Corporation.

Claim Rejections – 35 U.S.C. § 102

Claims 18-20 stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent No. 6,757,906 to Look et al. (hereinafter "Look"). Applicants respectfully traverse the rejection.

Look discloses an invention that provides a "user interface" (col. 4, line 43) or "viewer interface" (col. 4, line 48) for interfacing with a user or a viewer.

In the present application, independent claim 18 recites "an interface field programmable gate array (FPGA) configured to interface with a consumer premise component (CPC)". The Office Action cites col. 8, lines 29-30, for this feature. Applicants respectfully point out that the cited portion of Look trivially discloses a FPGA, but does not disclose that the FPGA is an "**interface** field programmable gate array (FPGA) **configured to interface with a consumer premise component (CPC)**".

Instead, Look merely teaches that “Media Switch 701 can be implemented in hardware using a field programmable gate array (FPGA), ASIC, or discrete logic.”

Accordingly, the FPGA that is disclosed in the cited portion of Look implements a Media Switch. However, Look fails to disclose an FPGA that interfaces “with a consumer premise component,” as claim 18 requires. The Media Switch disclosed by Look receives MPEG streams from one or more Input Modules, and outputs MPEG streams to one or more Output Modules (see FIGs. 1 and 2), but does not “interface with a consumer premise component (CPC)” as claim 18 requires. Consequently, Look does not provide any “interface field programmable gate array (FPGA) configured to interface with a consumer premise component (CPC)” and, thus, the invention as claimed.

Because Look fails to disclose any “interface field programmable gate array (FPGA) configured to interface with a consumer premise component (CPC)”, as recited in claim 18, claim 18 is not anticipated by Look. Claims 19 and 20, which depend from claim 18, are also not anticipated by Look at least by virtue of their dependency upon claim 18.

In addition, claim 19 recites “said upgrade decoder is configured to be **removably coupled** to said CPC” (emphasis added). The Office Action cites FIG. 2 and col. 5, lines 35-43, for this feature. Applicants respectfully point out that Look does not use the words “removably coupled” (or “removable,” or the like) to describe an upgrade decoder, or to describe a decoder of any kind. The Office Action incorrectly seems to infer the required feature of “removably coupled” from Look’s disclosure of “multiple decoders” and “multiple input sections,” or from Look’s disclosure of “separate decoders” at col. 5, line 49; however, such an interpretation finds no support in the disclosure of Look. Look fails to disclose the feature of an “upgrade decoder [that] is configured to be removably coupled to said CPC,” and thus, the invention as claimed in claim 19.

As Look fails to disclose each and every element of claims 18-20, Applicants respectfully submit that claims 18-20 are not anticipated by Look, and request that the rejection of claims 18-20 under 35 U.S.C. § 102(e) be withdrawn.

Claim Rejections – 35 U.S.C. § 103**Claims 1-8**

Claims 1-7 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Publ. No. 2003/0041104 to Wingard et al. (hereinafter “Wingard”) in view of U.S. Publ. No. 2003/0140237 to Bacon et al. (hereinafter “Bacon”). Claim 8 stands rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Wingard in view of Bacon and further in view of U.S. Publ. No. 2002/0133824 to Mensch (hereinafter “Mensch”). Applicants respectfully traverse the rejections.

In the present application, the Office Action acknowledges that the Wingard reference does not describe “downloading a computer program code to said CPC, said code enabling said CPC to access said upgrade decoder.” To make up for these shortcomings, the Examiner relies on the Bacon reference, citing the abstract thereof. However, Bacon does not disclose the required feature of “code **enabling said CPC to access said upgrade decoder**” (emphasis added). Instead, Bacon trivially teaches “downloading new program code from the headend,” but Bacon nowhere discloses that such “new program code” enables a customer premise component to access an upgrade decoder.

Furthermore, independent claim 1 recites “communicatively coupling a removable upgrade decoder to a consumer premise component (CPC), said upgrade decoder being configured to decode a data stream”. The Office Action cites paragraph 0060 of Wingard for this feature. However, the cited portion of Wingard, in the course of describing FIG. 3, merely discloses that a “tuner 300 is coupled to a decoder 306.” To the extent that the Office Action appears to equate the tuner to a consumer premise component, the Applicants point out (with reference to FIG. 3 of Wingard) that the tuner and the decoder are both disclosed to be parts of a single component – the client terminal 108 – and are both shown to be coupled by a bus 301 which is also a part of the client terminal 108. Thus, Wingard does not disclose that the decoder is communicatively

coupled **to a CPC**, as required by claim 1. Wingard also does not disclose that the decoder is **removable**, as required by claim 1. The Bacon reference fails to remedy the aforementioned deficiencies in Wingard.

The Wingard and Bacon references, taken either alone or in combination, do not describe “communicatively coupling a **removable** upgrade decoder **to a consumer premise component (CPC)**, said upgrade decoder being configured to decode a data stream” (emphasis added), and do not describe “downloading a computer program code to said CPC, said code **enabling said CPC to access said upgrade decoder**” (emphasis added), all of which features are recited in claim 1. Since Bacon fails to supply features missing from Wingard, the combination of Wingard and Bacon cannot suggest the presently claimed invention and cannot render the claims obvious. Thus, no matter how Wingard and Bacon may be combined (even assuming, *arguendo*, that one of ordinary skill in the art would be led to combine them) the resulting combination is not the invention recited in independent claim 1.

Independent claim 1 is allowable for at least the reasons set forth above. Claims 2-8, which depend from claim 1 and incorporate all of the limitations thereof, are patentable at least by virtue of their dependency upon claim 1. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-8 under 35 U.S.C. § 103(a).

Claims 9-17

Claims 9-10 and 13-15 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Wingard in view of U.S. Pat. No. 6,990,203 to Glaab (hereinafter “Glaab”). Claims 11-12 and 16-17 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Wingard in view of Bacon and further in view of Glaab. Applicants respectfully traverse the rejections.

Independent claim 9 recites the feature of a “first interface FPGA [that] is configured to be communicatively coupled to a removable upgrade decoder, said removable upgrade decoder including a second interface FPGA communicatively coupled to a second signal decoder.”

The Office Action, at page 9, acknowledges that the Wingard reference fails to teach this feature. To make up for these shortcomings, the Examiner relies on the Glaab reference, citing column 8, lines 1-3.

In view of the Statement of Common Ownership given above, which is made in a clear and conspicuous manner in a separately labeled section of this response, Applicant respectfully submits that the Glaab reference is disqualified as prior art. See MPEP § 706.02(I)(2)(II). The assignment of Glaab to General Instrument Corporation appears on the face of the issued patent, U.S. Pat. No. 6,990,203. The assignment of the present application to General Instrument Corporation is recorded at Reel 014969, Frame 0847. Thus, Applicants respectfully submit that the Glaab reference is disqualified as prior art under 35 U.S.C. § 103(c).

Because Glaab is an improper basis for rejecting Applicants' claims, the combination of Glaab with Wingard, with Bacon, or with other prior art references, also is an improper basis for rejecting Applicants' claims.

For at least the reasons previously stated, independent claim 9 is allowable. Likewise, dependent claims 10-17, which depend on claim 9 and incorporate all of the limitations thereof, are similarly patentable. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 9-17 under 35 U.S.C. § 103(a).

Claim 21

Claim 21 stands rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Look in view of Wingard and further in view of Glaab. Applicants respectfully traverse the rejection.

In view of the Statement of Common Ownership given above, as more fully discussed with regard to claims 9-17 above, Applicant respectfully submits that the Glaab reference is disqualified as prior art. Because Glaab is an improper basis for rejecting Applicants' claims, the combination of Glaab with Wingard and Look, or with other prior art references, also is an improper basis for rejecting Applicants' claims.

In addition, independent claim 18 is allowable for at least the reasons set forth

above with regard to the Office Action's rejection of claim 18 under 35 U.S.C. § 102. Claim 21, which depends from claim 18 and incorporates all of the limitations thereof, is patentable at least by virtue of its dependency upon claim 18.

Accordingly, Applicants respectfully request withdrawal of the rejection of claim 21 under 35 U.S.C. § 103(a).

Claims 22-25

Claims 22-24 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Bacon in view of Look. Claim 25 stands rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Bacon in view of Look and further in view of Mensch. Applicants respectfully traverse the rejections.

Independent claim 22 recites “downloading a computer program code to said CPC, said code enabling said CPC to access said upgrade decoder.” The Examiner relies on the Bacon reference for this feature, citing the abstract thereof. However, Bacon does not disclose the required feature of “code **enabling said CPC to access said upgrade decoder**” (emphasis added). Instead, Bacon trivially teaches “downloading new program code from the headend,” but Bacon nowhere discloses that such “new program code” enables a customer premise component to access an upgrade decoder. The Look and Mensch references fail to remedy the aforementioned deficiencies in Bacon.

For at least the foregoing reasons, independent claim 22 is allowable. Claims 23-25, which depend from claim 22 and incorporate all of the limitations thereof, are patentable at least by virtue of their dependency upon claim 22.

Accordingly, Applicants respectfully request withdrawal of the rejection of claims 22-25 under 35 U.S.C. § 103(a).

Conclusion

In view of the foregoing discussion, it is believed that claims 1-25 are allowable over the cited art. Applicants respectfully submit that all pending claims are in condition for allowance, and earnestly request that all objections and rejections of the claims be

withdrawn and a Notice of Allowance be entered at the earliest date possible.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

Respectfully submitted,
AARON J. BARBER, et al.

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BY: /Stewart M. Wiener/
Stewart M. Wiener
Registration No. 46,201
Attorney for Applicants

MOTOROLA, INC.
101 Tournament Drive
Horsham, PA 19044
Telephone: (215) 323-1811
Fax: (215) 323-1300